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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

1400.4100253

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11-30-2006

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Typed or printed name Ross D. Snyder, Reg No 37730

Application Number

09/606,860

Filed

06-28-2000

First Named Inventor

David W. Carr

Art Unit

2616

Examiner

Phan, Man U

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 37,730☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

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Telephone number

11-30-2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): David W. Carr

Title: METHOD AND APPARATUS FOR PACKET REASSEMBLY IN A
COMMUNICATION SWITCH

App. No.: 09/606,860

Filed: 06-28-2000

Examiner: Phan, Man U

Group Art Unit: 2616

Atty. Dkt. No. 1400.4100253

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Claims 1-28 are pending in the application. The Examiner has rejected claims 1, 2, 4-9, 13-19, 21-26, and 28. Claims 3, 10-12, 20 and 27 are objected to by the Examiner. Appellant respectfully requests reconsideration of pending claims 1-28. Appellant files herewith a notice of appeal. Pursuant to the "New Pre-Appeal Brief Conference Pilot Program," 1296 Off. Gaz. Pat. Office 67 (July 12, 2005) and the "Extension of the Pilot Pre-Appeal Brief Conference Program" dated 1/10/2006, Appellant submits a pre-appeal brief request for review. The review is requested for the reasons set forth below:

Appellant submits there exist clear errors in the Examiner's rejections and/or the Examiner's omissions of one or more essential elements needed for a *prima facie* rejection. Appellant submits the Examiner's "Response to Arguments" provides evidence that the Examiner has failed to consider the pending claims as required by the Manual of Patent Examining Procedure (MPEP) and prevailing case law. MPEP § 2141 sets forth the Graham inquiries for a rejection under 35 U.S.C. § 103. MPEP § 2143 describes basic requirements of a *prima facie* case of obviousness under 35 U.S.C. § 103. As Appellant describes in detail below, Appellant submits there exist clear errors in the Examiner's rejections and/or the Examiner's omissions of one or more essential elements needed for a *prima facie* rejection.

In the Examiner's "Response to Amendment and Argument," the Examiner states "It is not necessary that a 'prima facie' case of unpatentability exist as to the claim in order for 'a substantial new question of patentability' to be present as to the claim. Thus, 'a substantial new question of patentability' as to a patent claim could be present even if the examiner would not necessarily reject the claim as either fully anticipated by, or obvious in view of, the prior art patents or printed publications. As to the importance of the difference between 'a substantial new question of patentability' and a 'prima facie' case of unpatentability see generally *In re Etter*, 756 F.2d 852, 857 n.5, 225 USPQ 1, 4 n.5 (Fed. Cir. 1985)."

Appellant notes the Federal Circuit states, in *In re Etter*, 756 F.2d 852, 857 n.5, 225 USPQ 1, 4 n.5 (Fed. Cir. 1985), as follows:

The inquiry occasioned by a request for reexamination is solely whether a reexamination order should issue and is not directed toward resolution of validity. The requestor's burden is simply to show a basis for issuance of the order, a burden unrelated to that assigned in § 282. A refusal of reexamination leaves untouched the § 282 presumption to which the patent is entitled in the courtroom. Similarly, a reexamination may involve only certain claims, e.g., those in litigation, and the newly cited prior art may bear no relation to other claims, to which the presumption of validity would remain attached in future litigation involving those claims.

Not only does Appellant not see reference to "the importance of the difference between 'a substantial new question of patentability' and a 'prima facie' case of unpatentability" in the cited note, but Appellant submits the cited note appears directed toward criteria for a request for reexamination, which is not at issue in the present application. Accordingly, Appellant submits the Examiner's citation of *In re Etter* does nothing to counter Appellant's previously presented argument that the Examiner has failed to present a *prima facie* case of obviousness.

Moreover, Appellant submits the phrase "substantial new question of patentability" typically refers to a determination under 35 U.S.C. 303(a) in response to the filing of a request for reexamination, which Appellant notes has not been filed in the present application. Accordingly, Appellant submits the Examiner's statements as to "a substantial new question of patentability" and its alleged relationship to "a 'prima facie' case of unpatentability" are moot with respect to the present application.

The Examiner further cites MPEP §§ 2141.01(a) and 2131.05 with respect to "analogous and nonanalogous art" but fails to explain how such citations respond to Appellant's previously presented arguments. Accordingly, Appellant submits such citations do nothing to counter Appellant's previously presented arguments. Thus, consonant with Appellant's previously presented arguments, Appellant submits the Examiner has failed to present a *prima facie* showing of obviousness.

The Examiner further states, "However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re Laughlin*, 170 USPQ 209 (CCPA 1971)." Appellant submits the Examiner appears to read *In re Laughlin* as giving license to depart from the requirements of MPEP §§ 706.02(j) and 2142-2143.03. Appellant's reading of MPEP §§ 706.02(j) and 2142-2143.03 and *In re Laughlin* does not support an understanding that any of the requirements described in MPEP §§ 706.02(j) and 2142-2143.03 are so excused.

The Examiner also states, "However, the references are applied herein merely for the teaching of a segmentation and reassembly system cooperating with a data processing system having at least one central processing unit connected through a CPU interface and special purpose engines, and the segmentation and reassembly system comprises a plurality of frame buffers for storing pieces of data selectively supplied from first ATM cells and a processing means connected to the plurality of frame buffers for selectively accessing pieces of data and selectively supplying at least selected pieces of data to the special purpose engines through an exclusive interface for modifying the pieces of data, if necessary (See Fig. 1; Col. 2, lines 9 plus)." Appellant submits the Examiner's application of the references for such an admittedly limited purpose supports Appellant's contention that the Examiner has failed to present a *prima facie* showing of obviousness, as Appellant submits the Examiner fails to show suggestion in the prior art of the features recited in the claims. Moreover, while Appellant sees no assertion by the Examiner of teachings in the cited references relating to, for example, "in response to receipt of a first cell of a packet corresponding to a selected source of a plurality of sources, allocating a reassembly context to the selected source," "updating the reassembly context to reflect storage of the first cell in the buffer," "updating the reassembly context as each subsequent cell is stored in the buffer," or "deallocating the reassembly context," the Examiner states, "One skilled in the art would have recognized the need for effectively and efficiently reassembling packets using a limited number of reassembly context in an ATM communication network...." Appellant submits the Examiner fails to cite any teaching in the cited references that would support such a conclusion. Also, Appellant notes the Examiner's conclusion does not appear to allege obviousness of the specific features recited in the claims, which Appellant submits is evidence of the Examiner failing to resolve and set forth in the Office action "the difference or differences in the claim over the applied reference(s)," in accordance with MPEP § 706.02(j). Furthermore, Appellant submits the Examiner's bald assertion that "One skilled in the art would have recognized the need for effectively and efficiently reassembling packets using a limited number of reassembly context in an ATM

communication network...." fails to provide "an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification," in accordance with MPEP § 706.02(j). Thus, Appellant submits the Examiner has failed to present a *prima facie* showing of obviousness.

The Examiner cites *In re Laughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971), as holding "The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art" and "It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper." However, Appellant submits the "combination of disclosures taken as a whole" lack teaching or suggestion as to features recited in the claims. Moreover, Appellant submits the Examiner does not cite references (besides Applicant's disclosure) from which such features may have been gleaned. For example, Appellant submits the Examiner has not shown the "combination of disclosures taken as a whole" to teach or suggest "in response to receipt of a first cell of a packet corresponding to a selected source of a plurality of sources, allocating a reassembly context to the selected source" or "deallocating the reassembly context." Accordingly, Appellant submits the Examiner's purported "reconstruction" is improper under *In re Laughlin*.

The Examiner cites *In re Nomiya*, 184 USPQ 607 (CCPA 1975) as holding "...that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references." However, Appellant submits the Examiner appears not only to attempt to combine the cited references without a valid reason why one skilled in the art would be motivated to make the proposed combination, but also asserts as the purported motivation a teaching ("effectively and efficiently reassembling packets using a limited number of reassembly context in an ATM communication network") apparently absent from the cited references. Thus, Appellant submits the purported motivation not only fails to serve as a reason why one skilled in the art would be motivated to make the proposed combination but also underscores the inadequacy of the proposed combination even if some motivation to combine were to exist. Thus, Appellant submits the Examiner's purported rejection is unsound under *In re Nomiya*.

Appellant further notes that, while the Examiner copies and pastes (without quotation) col. 7, lines 35-48 and lines 57-62, of the Aramizu reference into the Examiner's "Response to Amendment and Arguments," the Examiner parenthetically alleges such portions of the cited reference teaching

only "(storing the cells in a buffer and updating the reassembly context to reflect storage of the cells in the buffer)." While Appellant notes the cited portion states, in part, "The ATM cell receiver 1 selectively writes pieces of payload and associated control data into the frame buffers 31 to 3n through the internal bus system 40," and Appellant can find no teaching as to "updating the reassembly context..." Appellant further submits that the Examiner appears to have failed to allege any teachings in the cited reference as to certain features of the claims, for example, "in response to receipt of a first cell of a packet corresponding to a selected source of a plurality of sources, allocating a reassembly context to the selected source" and "deallocating the reassembly context." Thus, Appellant submits the Examiner has failed to present a *prima facie* showing of obviousness.

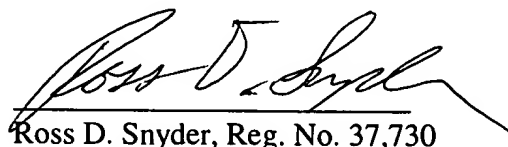
The Examiner has rejected claims 1, 2, 4-8, 18, 19, and 21-25 under 35 U.S.C. § 103(a) as being unpatentable over Aramizu et al. (U.S. Patent No. 6,493,356) in view of Ganmukhi et al. (U.S. Patent No. 6,233,243). Appellant respectfully disagrees. As Appellant submits the Examiner's "Response to Amendment and Argument" is deficient under the case law cited by the Examiner, as well as under the provisions of the MPEP cited by Appellant, as noted by Appellant above, Appellant reiterates Appellant's previously presented arguments. Thus, Appellant submits claims 1, 2, 4-8, 18, 19, and 21-25 are in condition for allowance.

The Examiner has rejected claims 9, 13-17, 26, and 28 under 35 U.S.C. § 103(a) as being unpatentable over Aramizu et al. (U.S. Patent No. 6,493,356) in view of Ganmukhi et al. (U.S. Patent No. 6,233,243) as applied to the claims above, and further in view of O'Neill et al. (U.S. Patent No. 6,243,382). Appellant respectfully disagrees. As Appellant submits the Examiner's "Response to Amendment and Argument" is deficient under the case law cited by the Examiner, as well as under the provisions of the MPEP cited by Appellant, as noted by Appellant above, Appellant reiterates Appellant's previously presented arguments. Thus, Appellant submits claims 9, 13-17, 26, and 28 are in condition for allowance.

Respectfully submitted,

11-30-2006

Date


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